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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,522	07/26/2001	Jin-Kwan Kim	8071-174T	6306
22150 7590 05/07/2007 F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			EXAMINER WASSUM, LUKE S	
			ART UNIT 2167	PAPER NUMBER
			MAIL DATE 05/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/912,522	Applicant(s) KIM ET AL.	
	Examiner Luke S. Wassum	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20061121</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. Regarding the instant application, the Office issued a Notice of Allowance on 16 June 2006. The issue fee was received on 1 September 2006, and an Information Disclosure Statement was received on 22 November 2006, but not considered as having been not timely filed.

2. On 16 March 2007, the Office mailed a Notice of Withdrawal from Issue under the provisions of 37 C.F.R. § 1.313(b)(3), due to the unpatentability of one or more claims.

3. Prosecution is hereby reopened.

Examiner of Record

4. The Applicants are advised that the examiner of record for this application has changed. Contact information for the new examiner can be found at the conclusion of this Office action.

The Invention

5. The instant invention is a system for and method of analyzing and utilizing intellectual property.

Priority

6. The Applicants' claim to foreign priority under 35 U.S.C. § 119(a)-(d) based upon Korean patent application 2000-43108, filed 26 July 2000, is acknowledged. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

7. The Applicants' Information Disclosure Statement, filed 21 November 2006, has been received and entered into the record. Since the Information Disclosure Statement complies with the provisions of MPEP § 609, the references cited therein have been considered by the examiner. See attached form PTO-1449.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Art Unit: 2167

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Regarding claims 4, 5, 7-12 and 14-17, these claims are for a system for for analyzing and utilizing intellectual property (IP) information. However, all of the elements claimed could be reasonably interpreted in light of the disclosure by an ordinary artisan as being software alone, and thus is directed to functional descriptive material [software *per se*], which is non-statutory. See *In re Warmerdam* (CAFC) 31 USPQ2d 1754 at 1759.

In order for software claims to be statutory, they must be claimed in combination with an appropriate medium and/or hardware to establish a statutory category of invention and enable any functionality to be realized. Compare *In re Lowry* (CAFC) 32 USPQ2d 1031 at 1031,1035 (claim to a data structure stored on a computer readable medium that increases computer efficiency held statutory) and *In re Warmerdam* (CAFC) 31 USPQ2d 1754 at 1759 (claim to computer having a specific data structure stored in memory held a statutory product-by-process claim) with *In re Warmerdam* (CAFC) 31 USPQ2d 1754 at 1760 (claim to a data structure per se held non-statutory).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by **Unger et al.** (U.S. Patent 5,721,910).

12. Regarding claim 1, **Unger et al.** teaches a method for analyzing and utilizing intellectual property (IP) information as claimed, comprising steps of:

- a) **registering search strategy formulas for extracting IP information** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66);
- b) **accessing and searching Internet websites that provide IP information based on the registered search strategy formulas, and extracting first IP information according to the search** (see disclosure that a set of expert

searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2);

- c) **converting the first IP information to a standard form and storing the first IP information, and transmitting the first IP information converted in the standard form to research center personal computers (PCs)** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51);
- d) **determining whether a request for detailed information has been made from the research center PCs, and in the case where such a request has been made accessing the Internet websites and extracting second IP information corresponding to the first IP information** (see disclosure that specific detail on individual documents and/or abstracts and/or claims may also be captured in discrete fields and linked to the categories within the hierarchical model and the technical documents and/or abstracts and/or

claims, and can be linked to full-text sources of the documents, col. 2, lines 40-46);

e) **converting the second IP information to a standard form and storing the second IP information, and transmitting the second IP information converted in the standard form to research center personal computers (PCs)** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51);

wherein the step (c) includes steps of:

i) **determining if third IP information has been received from the research center PCs, the third IP information including technical analyses and opinion contents** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45); and

ii) **storing the third IP information if the third IP information has been received** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45).

13. Regarding claim 3, **Unger et al.** additionally teaches a method for analyzing and utilizing intellectual property (IP) information wherein step (e) includes steps of:

i) **determining if fourth IP information has been received from the research center PCs, the fourth IP information including technical analyses and opinion contents** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45); and

ii) **storing the fourth IP information if the fourth IP information has been received** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 4-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Unger et al.** (U.S. Patent 5,721,910) in view of **Walker et al.** (U.S. Patent 5,862,223).

18. Regarding claim 4, **Unger et al.** teaches a system for analyzing and utilizing intellectual property (IP) information substantially as claimed, comprising:

- a) **an IP information extraction unit for extracting IP information according to operation of software from at least one on-line IP information database (DB) found on the Internet or on a network** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2);

b) **an IP information analyzing unit for controlling the operation of the software, receiving the extracted IP information and storing the same together with data containing opinion contents of the extracted IP information from research center personal computers (PCs), and outputting the IP information** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45);

wherein the IP information extraction unit comprises:

i) **a front page extraction unit for requesting front pages of IP information according to a universal resource locator (URL) for accessing the on-line IP information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the front pages**

(see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure at Stage III of drawing Figure 1 of front page information received and parsed into the database; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).

Unger et al. does not explicitly teach a system including an email receiving/transmitting unit, although the fact that it does disclose the accessing of patents and/or technical documents over the Internet provides strong evidence of obviousness for the inclusion of email capability.

Walker et al., however, teaches a system including an email receiving/transmitting unit (see col. 15, lines 21-42 et seq.), the Applicants' limitations of transmitting IP information and receiving opinion contents via email having been

given no patentable weight as being merely a statement of intended use, although the reference also discloses the exchange of information between requester and an expert (see col. 18, lines 31-56; see also col. 26, lines 15-21).

It would have been obvious to include email capabilities in the system disclosed in the **Unger et al.** reference, since this would facilitate the exchange and accumulation of analysis and opinion information from experts without the necessity of having the experts all co-located at the central information facility.

19. Regarding claim 11, **Unger et al.** teaches a system for analyzing and utilizing intellectual property (IP) information substantially as claimed, comprising:

- a) **an IP information extraction unit for extracting IP information according to operation of software from at least one on-line IP information database (DB) found on the Internet or on a network** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or

technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2);

- b) **an IP information analyzing unit for controlling the operation of the software, receiving the extracted IP information and storing the same together with data containing opinion contents of the extracted IP information from research center personal computers (PCs), and outputting the IP information** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45);

wherein the IP information extraction unit comprises:

- i) **a management module for generating technical classifications and search strategy formulas for extracting IP information** (see disclosure that the database disaggregates a set of patents and/or

technical documents into discrete technical categories by use of a set of pre-defined search protocols which match the scientific or technical concepts within the model, col. 3, lines 8-17).

Unger et al. does not explicitly teach a system including an email receiving/transmitting unit, although the fact that it does disclose the accessing of patents and/or technical documents over the Internet provides strong evidence of obviousness for the inclusion of email capability.

Walker et al., however, teaches a system including an email receiving/transmitting unit (see col. 15, lines 21-42 et seq.), the Applicants' limitations of transmitting IP information and receiving opinion contents via email having been given no patentable weight as being merely a statement of intended use, although the reference also discloses the exchange of information between requester and an expert (see col. 18, lines 31-56; see also col. 26, lines 15-21).

It would have been obvious to include email capabilities in the system disclosed in the **Unger et al.** reference, since this would facilitate the exchange and accumulation

of analysis and opinion information from experts without the necessity of having the experts all co-located at the central information facility.

20. Regarding claim 5, **Unger et al.** additionally teaches a system wherein the IP information extraction unit further comprises:

- a) **a data converter for converting front page data and outputting the same to the IP information analyzing unit** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure at Stage III of drawing Figure 1 of front page information received and parsed into the database; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).); and
- b) **a specialized information extraction unit for requesting specialized IP information according to a URL for accessing the on-line information**

DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the specialized IP information (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).

21. Regarding claims 6 and 13, **Unger et al.** additionally teaches a system wherein the IP information analyzing unit further comprises:

- a) **a first DB for storing patent team opinion contents of at least one of front pages or specialized pages** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45);
- b) **a second DB for storing research center opinion contents of at least one of front pages or specialized pages** (see disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of

expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45);

c) **a quantitative analysis unit for outputting predetermined quantitative analysis graphs** (see drawing Figures 2 through 4);

d) **a management module for generating technical classifications and search strategy formulas for extracting IP information** (see disclosure that the database disaggregates a set of patents and/or technical documents into discrete technical categories by use of a set of pre-defined search protocols which match the scientific or technical concepts within the model, col. 3, lines 8-17); and

e) **a DB management unit for receiving the front pages or specialized pages from the IP information extraction unit and storing this information in the first DB, storing the research center opinion contents received from the research center PCs in the second DB, and outputting signals for generating analysis graphs to the quantitative analysis unit** (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a

computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure of the storage of a matrix of expert opinions, representing the cumulative opinion of a group of expert technical staff and/of scientists, col. 10, lines 40-48; see also col. 11, lines 34-45).

22. Regarding claims 7 and 14, **Unger et al.** additionally teaches a system wherein **extraction periods of the IP information extraction unit are in real-time or programmed at predetermined intervals** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, and that this new set may represent recently published patents or technical documents, col. 5, line 64 through col. 6, line 1, explicitly disclosing the real-time extraction of IP information, and clearly suggesting extraction performed at predetermined intervals).

23. Regarding claims 8 and 15, **Unger et al.** additionally teaches a system wherein **the IP information extraction unit stores a plurality of predetermined keywords** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66).

24. Regarding claims 9 and 16, **Unger et al.** additionally teaches a system wherein **the IP information analyzing unit separates and displays analyzed data and data that have not been analyzed** (see disclosure that the system allows patents and/or technical documents to be electronically captured and analyzed at a convenient time, col. 6, lines 24-26).

25. Regarding claims 10 and 17, **Walker et al.** additionally teaches a system wherein **the email receiving/transmitting unit registers a plurality of predetermined email addresses according subject or field** (see disclosure of the expert database including email address and expert profile including subject area of expertise, col. 14, lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to maintain a list of email addresses according to subject or field, since this would allow a user to submit a request to an expert having expertise in a subject field which corresponds to the request.

26. Regarding claim 12, **Unger et al.** additionally teaches a system wherein the IP information extraction unit further comprises:

a) a front page extraction unit for requesting front pages of IP information

according to a universal resource locator (URL) for accessing the on-line IP information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the front pages (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure at Stage III of drawing Figure 1 of front page information received and parsed into the database; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2);

b) a data converter for converting front page data and outputting the same to

the IP information analyzing unit (see disclosure that the documents and/or abstracts and/or claims and/or technical indexing may be electronically stored in a relational database and linked to the categorization which reflects the overall hierarchical model, and

furthermore that the documents, etc., can be displayed on a computerized graphical interface [research center personal computers], col. 3, lines 46-51; see also disclosure at Stage III of drawing Figure 1 of front page information received and parsed into the database; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).); and

- c) **a specialized information extraction unit for requesting specialized IP information according to a URL for accessing the on-line information DB, and pre-registered access information including an access period, technical classifications, and a search format, and receiving and outputting the specialized IP information** (see disclosure that a set of expert searches [search strategy formulas] can be executed against a new set of patents and/or technical documents, col. 5, lines 64-66; see also col. 7, lines 26-40; see also disclosure that the full-text sources of patents or technical documents can reside on the Internet, col. 3, line 66 through col. 4, line 2).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
2 May 2007